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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,361	02/16/2000	John M. Packes JR.	99-025	6202
22927	7590	10/08/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,361

Applicant(s)

PACKES ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,34-43 and 47-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28,34-43 and 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 7/21/04.

Claim Objections

1. Claims 47-52 are objected to because of the following informalities:
 - Claims 47-52, "determine whether a second rebate has been surrendered" should be replaced by the more appropriate "determine whether a second rebate has been designated as surrendered" for clarity. The system only knows what you tell it, not whether the surrender has actually occurred properly.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 28, 34, 35, 38, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Quaker State reacts quickly to Sears bottle, Oil Daily 4/1/1987) in view of Fajkowski (US5905246).

Regarding claims 1, 34, 35, 38, Moore (end of article) teaches the idea of offering an instant rebate at a retail store in exchange for an available mail-in rebate. The mail-

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in procedure is then handled on behalf of the customer. This is taken to encompass identification of a product and its available, associated, first, mail-in rebate as well as the offering of a second, instant rebate in exchange for the first mail-in rebate. The step of handling the mail-in procedure on behalf of the customer is taken to inherently provide a surrendering of the appropriate document(s) required for mail-in redemption. However, Official Notice is taken that it is known to require a proof of purchase document to be mailed in order to redeem the mail-in rebate. It would have been obvious to one of ordinary skill at the time of the invention to have required the customer to surrender such a document so that the retailer can successfully handle the mail-in procedure for the customer. Although preventing a customer from redeeming the first (mail-in) rebate is claimed merely as functional language, this surrendering step of Moore accomplishes such. The surrendering "at a terminal" is very broad and requires no more than a "location" or simply in a store that includes a computer terminal – no interaction with the terminal specified. However, Moore teaches surrendering at a service counter location which would have been obvious to one of ordinary skill at the time of the invention to have included a computer terminal for handling/registering/tracking such instant rebates as well as other service counter functions such as returns, etc. Nonetheless, Fajkowski teaches storing available manufacturer's rebates in a database that is queried at the POS terminal. If the customer purchases the appropriate product(s), the customer is offered the opportunity to instantly receive credit on the current purchase [col 24 lines 54 to col 25 line 16]. It would have been obvious to one of ordinary skill at the time of the invention to have

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obtained the mail-in documents so the retailer could handle the rebate, yet (as taught by Fajkowski) instantly redeemed the value on the current transaction at the POS as a way of conveniently paying the customer for the rebate. Moore states that they do not cash the rebates at the POS, yet do not prevent such an idea (also shared by Fajkowski).

Regarding claims 2, 3, the words "term" and "condition" are both taken to require a "stipulation" associated with the rebate and no distinction is required between the two words. Both the retail and manufacturer rebates require purchase of the qualifying product; this stipulation is taken to provide a condition and/or term of the rebate. Similarly, the value of the rebates are both inherently associated with and based on the value of the original product.

Regarding claim 4, claiming a rebate as a "POS rebate" is quite broad and can include a rebate having any characteristic associated with a point of sale, such as selection at, issuance at, redeeming at or qualifying for at a point of sale. Fajkowski teaches that the second rebate can be issued at the POS.

Regarding claim 5, the customer's choice (in Moore) to accept the instant 2nd rebate in exchange for the 1st rebate reads on accepting input indicative of a selection of the alternative rebate. However, Fajkowski also teaches getting electronic input at the POS from the customer on whether to accept the offer which would have been obvious to have done in order to automate the decision process.

Regarding claim 28, Fajkowski teaches that it is known to determine the amount due to the retailer from the manufacturer for manufacturer promotions [2:28-31].

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However, the handling of the mail-in rebate on behalf of the customer inherently provides a reimbursement value for the retailer.

Regarding claims 47-50, it would have been obvious to one of ordinary skill at the time of the invention to have programmed the system to provide the automated instant 2nd rebate value only if the customer surrenders the mail-in documents, so that the retailer can be reimbursed when handle the mail-in procedures and further to prevent fraud by way of the customer attempting to redeem the 1st rebate later by mail.

4. Claims 6, 16, 17, 20, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view Fajkowski and further in view of Mori (US5200889).

Regarding claims 6, 39, 40, Mori teaches earning rebates and crediting them to a user account identified by a membership card until the user chooses to redeem them later [1:45-63, 5:8-13, 8:11-23]. It would have been obvious to one of ordinary skill at the time of the invention to have credited the value of the 2nd rebate to the customer's account/card at the POS during the current transaction for later redemption in a manner as taught by Mori so that the user can accumulate value to be used for larger, future purchases.

Regarding claims 16, 17, 20, the customer providing the card/identification and the customer returning to make a future purchase (inherently at least 1 future visit) where the stored rebate amount is used are taken to provide a terms and redemption conditions.

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5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Fajkowski, Mori (US5200889) and LA Times ("Loyalty: Check it out" 7/8/1994).

Regarding claim 11, LA Times teaches defining customer deals for customers based on their frequency of shopping, or characteristics of shopping. The disclosed rebates award a customer with a promotion that requires purchase of a specific product. It would have been obvious to one of ordinary skill at the time of the invention to have required the customer to purchase a particular product specified by the awarded coupon/promotion for participation, and modified the redeemed value based on the customer characteristics as taught by LA Times, so as to offer flexibility and targeted customer savings.

Claims 12, 13, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Fajkowski and Chew (US5901303). Chew teaches to dynamically change promotion values, depending on product sales/usage [col 7 lines 25-35]. It would have been obvious to one of ordinary skill at the time of the invention to have changed the value of the rebates based on such manufacturer information such as sales or redemption of the current promotion campaign, so that the promotion campaign can be altered to stimulate additional sales/redemptions if the campaign was not meeting expectations.

Claims 14, 15, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Fajkowski, Chew and LA Times ("Loyalty: Check it out" 7/8/1994).

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Regarding claims 14, 15, LA Times teaches defining customer deals for customers based on frequency of shopping, or characteristics of shopping. It would have been obvious to one of ordinary skill at the time of the invention to have based the rebate promotion values on characteristics of the customer, as taught by LA Times so as to offer flexibility and targeted customer savings.

Regarding claim 21, identification of the customer making the transaction is used as a basis for determining the promotional value, and is taken to be "information about a purchase transaction".

Regarding claims 22 and 26, it would have been obvious to one of ordinary skill at the time of the invention to classify a customer who returns as a frequent shopper, and it would have been obvious to one of ordinary skill at the time of the invention to have provided higher frequent-shopper benefits to such a customer so as to offer flexibility and targeted customer savings.

Regarding claims 23-25, 27, LA Times teaches "deadlines" for rebates, which is taken as an expiration deadline whereby the rebate value is "zero". Rebate value decreases to a value of zero for all redemption times past the deadline. A customer who does not make frequent purchases (over time) will not be classified as a frequent shopper and will not be eligible for such frequent-shopper promotional values.

6. Claims 7-10, 41-43, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Fajkowski and Mori.

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Regarding claims 51, 52, Mori teaches earning rebates and crediting them to a user account identified by a membership card until the user chooses to redeem them later [1:45-63, 5:8-13, 8:11-23]. It would have been obvious to one of ordinary skill at the time of the invention to have credited the value of the 2nd rebate to the customer's account/card for later redemption in a manner as taught by Mori so that the user can accumulate value for future purchases.

Regarding claims 41-43, the customer providing the card/identification and the customer returning to make a future purchase (inherently at least 1 future visit) where the stored rebate amount is used are taken to provide a terms and redemption conditions.

Regarding claims 7-10, such a combination provides offering the 2nd rebate at the POS and redemption of the 2nd rebate at any POS, including the same POS.

Allowable Subject Matter

Claims 18 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 and 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant argues that Moore does not teach a 2nd rebate. Examiner believes that the mail-in rebate is a 1st rebate and that the retailer-redeemed rebate is a 2nd rebate.

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Applicant argues that in many cases the examiner lacks motivation and presents merely a statement that the combination yields desirable results. This is taken to be proper motivation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc